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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/061,941	02/01/2002	Jose P. Pereira	N1-P113	8777
30554	7590	09/13/2004	EXAMINER	
SHEMWELL GREGORY & COURTNEY LLP 4880 STEVENS CREEK BOULEVARD SUITE 201 SAN JOSE, CA 95129			VERBRUGGE, KEVIN	
			ART UNIT	PAPER NUMBER
			2188	

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/061,941

Applicant(s)

PEREIRA ET AL.

Examiner

Kevin Verbrugge

Art Unit

2188

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-22 and 39-107 is/are allowed.
- 6) ☒ Claim(s) 23, 29-32 and 36 is/are rejected.
- 7) ☒ Claim(s) 24-28, 33-35, 37 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/28 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This final Office action is in response to the amendment filed 7/28/04 which amended several claims and fixed the numbering problems. The amendments and arguments overcome the art rejection of record and necessitated the new rejections below (based on references located during an updated patentability search). Claims 1-107 are pending. All objections and rejections not repeated below are withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-107 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-129 of U.S. Patent No. 6,697,276 to Pereira et al. Although the conflicting claims are not identical, they are not

patentably distinct from each other because the patented claims are to a device performing a method and the pending claims are to that same method.

For example, claim 1 of the patent claims an index generator, a memory, a compare circuit, and an interface to output the match signal and the index. Claim 1 of the instant application claims a method of generating an index (by an index generator by definition), determining whether bits stored in a memory match (by a compare circuit by definition), and outputting the index and the match signal.

Applicants are apparently attempting to patent an integrated circuit (in the patent) and a method of operation within an integrated circuit (instant application) as indicated by the preamble of the claims. These are not patentably distinct in the opinion of the Examiner. If Applicant continues to believe that an integrated circuit performing a method and a method of operation within the integrated circuit are patentably distinct even though the claims so closely resemble each other, then specific arguments supporting this position are required. It is not sufficient to request reconsideration in view of the amendments referred to above since the amendments do not address the issues mentioned in this section.

The public is served by requiring a terminal disclaimer in this application to prevent a patent term extension of the already-granted patent and to make sure this application and the patent remain commonly owned.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23, 29, 31, 32, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,724,538 to Morris et al.

Regarding claims 23 and 29, Morris shows the claimed method in Fig. 3. The claimed step of receiving a search value is performed by Morris' device when register 201 receives the virtual address shown, which includes virtual page number 203 and an unlabeled portion (which presumably includes a page offset as common in the art).

His device performs the claimed generating of an index based on just the virtual page number 203 in hash function 301.

His device performs the claimed determining step to determine whether the virtual page number 203 matches the virtual tag 307 stored in the page table 303 at the memory location indicated by the index (see column 3, line 53 through column 4, line 24).

Regarding claims 31, 32, and 36, Morris shows the claimed method in Fig. 3.

His device performs the claimed generating of an index based on the virtual page number 203 in hash function 301.

His device performs the claimed generating of an indication of a match between the virtual page number 203 and the stored virtual tag 307 stored in the page table 303 at the memory location indicated by the index (see column 3, line 53 through column 4, line 24). This indication of a match or no match is used to control traversal of the linked list or chain to find the stored virtual tag that matches the incoming virtual page number 203, since plural page numbers 203 will hash to the same page table entry 305.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,724,538 to Morris et al.

Morris does not disclose using the claimed CRC method for generating his hash value. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use CRC for its attendant advantages since it was a well-known hashing algorithm at the time of the invention.

Allowable Subject Matter

Claims 24-28, 33-35, 37, and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-22 and 39-107 are allowed.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

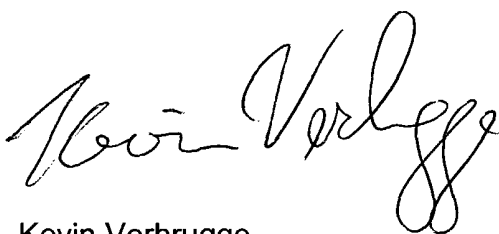
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning a communication from the Examiner should be directed to the Examiner by phone at (703) 308-6663 before 10/14/04 and at (571) 272-4214 after 10/14/04.

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Any response to this action should be labeled appropriately (serial number, Art Unit 2188, and After-Final, Official, or Draft) and mailed to Commissioner for Patents, Washington, D.C. 20231 or faxed to (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

A handwritten signature in black ink, appearing to read "Kevin Verbrugge". The signature is fluid and cursive, with the first name "Kevin" and last name "Verbrugge" clearly distinguishable.

Kevin Verbrugge
Primary Examiner
Art Unit 2188